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09/393,576	09/10/1999	MITSUNOBU ENOMOTO	P1216-9002	2928

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EXAMINER

DINH, KHANH Q

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2151

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/393,576
Filing Date: September 10, 1999
Appellant(s): ENOMOTO ET AL.

Michele L. Connell (Registration No.52,763)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/17/06 appealing from the Office action
mailed 1/17/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,898,819	AUSTIN ET AL	04-1999
5,491,781	GASPERINA	02-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 23-27, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austin et al., U.S Pat. No.5,898,819 in view of Gasperina US pat. No.5,491,781.

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As to claim 23, Austin discloses an Internet information method for receiving Internet information, displaying it on the screen, and display a tool bar composed of plural buttons each representing control function on the screen comprising:

selecting an arbitrary button (button 58 fig.2a) in said toolbar (fig.2a), magnifying and displaying said selected button (i.e., enlarge view of the button shown in fig.2b) displaying the button group and the individual buttons (buttons 54a-54i fig.2a) (see abstract, figs.2a, 2b, col.7 lines 14 to col.8 line 41 and col.9 lines 15-65).

Austin does not specifically disclose displaying magnifying button into a predetermined size in longitudinal and lateral directions. However, Gasperina discloses magnifying button into a predetermined size in longitudinal and lateral directions (see abstract, figs.1A, 1B, col.1 lines 31-60 and col.3 line 6 to col.4 line 65). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Gasperina 's teachings into the computer system of Austin to displaying information because it would have enabled users to vary a portion of an file display in a window on a monitor controlled by a computer and to select the scale of the displayed portion (see Gasperina's col.1 line 63 to col.2 line 13) and thus capable correcting reproduced image density automatically in accordance with a density of document ground.

As to claim 24, Austin discloses the state of the selected button is magnified in the direction toward the center of the screen at said step of magnifying and displaying said selected button (see figs.2a, 3, co1. 8 lines 1-58 and col.11 line 42 to col.12 line 43).

As to claim 25, Austin discloses characters for expressing the function of the button are also displayed at said step of magnifying and displaying said selected button (see figs.2a, 3, col.7 lines 14 to col.8 line 41 and col.11 line 42 to col.12 line 43).

As to claim 26, Austin discloses the step of varying the displaying state of said magnified and displayed button when executing the function of said selected button (see figs.2a, 2b, 3, col. 8 lines 1-58 and col.11 line 42 to col.12 line 43).

As to claim 27, Austin discloses the button is displayed in the depressed state from the screen at the step of varying the displaying state of said magnified and displayed button when executing the function of said selected button (see figs.2a, 3, col.7 lines 14 to col.8 line 41 and col.11 line 42 to col.12 line 43).

As to claim 30, Austin discloses Internet information for receiving Internet information, displaying it on the screen, and display a tool bar composed of plural buttons each representing control function on the screen comprising:

selecting an arbitrary button (button 58 of fig.2a) in said toolbar (54a-54i fig.2a) and displaying said selected button in a single user action (clicking the preview button, see abstract, figs.2a, 2b, col.7 lines 14 to col.8 line 41 and col.9 lines 15-65).

Austin does not specifically disclose magnifying button into a predetermined size in longitudinal and lateral directions. However, Gasperina discloses magnifying button into

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a predetermined size in longitudinal and lateral ((see abstract, figs.1A, 1B, col.1 lines 31-60 and col.3 line 6 to col.4 line 65). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Gasperina 's teachings into the computer system of Austin to displaying information because it would have capable correcting reproduced image density automatically in accordance with a density of document ground.

As to claim 31, Austin discloses that the display state of the selected button is magnified and moved in the direction toward the center of the screen (see figs.2a, 3, co1. 8 lines 1-58 and col.11 line 42 to col.12 line 43).

3. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austin and Gasperina and further in view of Schindler et al US pat. No.5,675,390.

As to claim 28, Austin discloses selecting an arbitrary button (button 58 of fig.2a) in said toolbar (54a-54i fig.2a) (user to click the preview button, see abstract, figs.2a, 2b, col.7 lines 14 to col.8 line 41 and col.9 lines 15-65). Neither Austin nor Gasperina discloses using a wireless remote control to select a button. However, a wireless remote control is generally well known in the art as disclosed by Schindler (using remote control to control functional buttons and key pads, see abstract, co1.13 line 45 to co1.14 line 55). It would have been obvious if not inherent to one of the ordinary skill in the art at the

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time the invention was made to implement a well-known device such as a wireless remote control in the computer system of Austin to control data because it would have provided Infrared signals and cordless telephone functionality between base units and remote units in a communication system network (see col.13 line 45 to col.14 line 55) and thus enabled users to access and to control data information more quickly.

As to claim 29, Austin discloses an Internet information displaying method for receiving Internet information, displaying it on the screen, and display a tool bar composed of plural buttons each representing control function on the screen comprising:

selecting an arbitrary button (button 58 fig.2a) in said toolbar (fig.2a), magnifying and displaying said selected button (i.e., enlarge view of the button shown in fig.2b) displaying the button group and the individual buttons (buttons 54a-54i fig.2a) (see abstract, figs.2a, 2b, col.7 lines 14 to col.8 line 41 and col.9 lines 15-65).

Austin does not specifically disclose displaying magnifying button into a predetermined size in longitudinal and lateral directions. However, Gasperina discloses magnifying button into a predetermined size in longitudinal and lateral directions (see abstract, figs.1A, 1B, col.1 lines 31-60 and col.3 line 6 to col.4 line 65). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Gasperina 's teachings into the computer system of Austin to displaying information because it would have enabled users to vary a portion of an file display in a window on a monitor controlled by a computer and to select the scale of the displayed portion (see Gasperina's col.1 line 63 to col.2 line 13) and thus capable correcting

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reproduced image density automatically in accordance with a density of document ground.

Neither Austin nor Gasperina discloses using a wireless remote control to select a button. However, a wireless remote control is generally well known in the art as disclosed by Schindler (using remote control to control functional buttons and key pads, see abstract, col.13 line 45 to col.14 line 55). It would have been obvious if not inherent to one of the ordinary skill in the art at the time the invention was made to implement a well-known device such as a wireless remote control in the computer system of Austin to control data because it would have provided Infrared signals and cordless telephone functionality between base units and remote units in a communication system network (see col.13 line 45 to col.14 line 55) and thus enabled users to access and to control data information more quickly.

(10) Response to Argument

Appellant has chosen to group the claims into 2 groups for argument:

Group I: claims 23-27 and 30-31.

Group II: claims 28 and 29.

A. Regarding Group I, pages 7-14 of the Appeal Brief are directed to these claims.

- Appellant argues that Austin does not suggest, disclose or imply magnifying any selected button.

Examiner respectfully disagrees. Austin discloses that in a screen display (in fig.2a) which enables user to select an arbitrary button (button 58 fig.2a is selected by user) and then magnifying (enlarging) the selected button (enlarging the view of the button as shown in fig.2b) (see abstract, figs.2a, 2b, col.7 line 14 to col.8 line 41 and col.9 lines 15-65). As a result, users can see and modify selected items using buttons an on screen presentation.

- Appellant argues that Gasperina does not disclose displaying magnifying button into a predetermined size in longitudinal and lateral directions.

Examiner respectfully point out that Gasperina discloses magnifying button (an image in a scroll box) into a predetermined size in longitudinal and lateral directions (enabling users to "zoom in" or "zoom out " a selected scroll box in different horizontal and vertical axis; thus users can adjust the display of the displayed data image in desired dimensions, see abstract, figs.1A, 1B, col.1 lines 31-60 and col.3 line 6 to col.4 line 65). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Gasperina 's teachings into the computer system of Austin to displaying information because it would have enabled users to vary a portion of an file display in a window on a monitor controlled by a computer and to select the scale of the displayed portion (see Gasperina's col.1 line 63 to col.2 line 13) and thus

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capable correcting reproduced image density automatically in accordance with a density of document ground. Therefore, the Examiner respectfully point out that the combination of Austin and Gasperina discloses the Application claimed invention.

- Appellant argues that the Examiner fail to provide sufficient motivation to combine the references and nothing from the applied references.

Appellant's argument is not persuasive. In response to appellant's argument that there is no sufficient suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Gasperina 's teachings into the computer system of Austin to displaying information because it would have enabled users to vary a portion of an file display in a window on a monitor controlled by a computer and to select the scale of the displayed portion (see Gasperina's col.1 line 63 to col.2 line 13) and thus capable correcting reproduced image density automatically in accordance with a density of document ground. Examiner has shown the proper motivation to combine the references in the Gasperina reference.

- Appellant argues that the Austin does not disclose magnifying a button in a single user action.

Examiner respectfully disagrees. Examiner respectfully point out that Austin discloses magnifying (enlarging the view of the selected button as shown in fig.2b) a button (58 fig.2a) in a single user action (after the arbitrary button 58 fig.2a is selected by user upon clicking the preview button) (see abstract, figs.2a, 2b, col.7 line 14 to col.8 line 41 and col.9 lines 15-65). As a result, users can see and modify selected items using buttons an on screen presentation.

B. Regarding Group II, pages 14-15 of the Appeal Brief are directed to these claims.

- Appellant argues that either Austin or Gasperina discloses a remote control or a wireless control and there is not sufficient motivation to combine references.

Examiner respectfully disagrees. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking the reference individually where the rejections are based on combinations of references. See In re Keller, 642F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant obviously attacks references individually without taking into consideration based on the teachings of the combinations of references as shown above. With respect to Austin and Gasperina, Appellant seems to argue points the Examiner has already construed either Austin or Gasperina does not teach "a remote control or a wireless control" while restricting the argument on the combination on the Austin and Gasperina and in view of Schindler combined to argument with no motivation. However, a wireless remote control is generally well known in the art as disclosed by Schindler (using remote control to control functional buttons and key pads, see abstract, col.13 line 45 to col.14 line 55). It would have been obvious if not inherent to one of the ordinary skill in the art at the time the invention was made to implement a well-known device such as a wireless remote control in the computer system of Austin to control data because it would have provided Infrared signals and cordless telephone functionality between base units and remote units in a communication system network (see col.13 line 45 to col.14 line 55) and thus enabled users to access and to control data information more quickly. Examiner has shown the proper motivation to combine the references in the Schindler reference.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

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8/1/2006

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